

#10/526000
11-23-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Greene *et al.*

Appl. No. 09/526,437

Filed: March 15, 2000

For: **Antibodies to Human Tumor
Necrosis Factor Receptor-Like
Genes (as amended)**

Confirmation No. N/A

Art Unit: 1647

Examiner: Seharaseyon, J.

Atty. Docket: 1488.0710005/EKS/KRM

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Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **October 23, 2001**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 19-60. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

MPEP 803 (Eighth Edition, August 2001), at page 800-4, left hand column, states as one of the criteria for restriction that : "There must be a serious burden on the examiner if restriction is required ...". Thus, the Patent Office encourages the assertion that examination of the entire application may take place where such search and examination can be made *without* serious burden, even though two separate, non-overlapping searches may be required.

In the present case, Applicants respectfully assert that the search of restriction groups I-III does not impose a serious burden upon the Examiner, as a search concerning the

patentability of the invention of one group is likely to uncover art of interest to the other group. At a minimum, the claims of Groups II and III should be examined together. The claims of these groups have been classified in the same class, and therefore, can clearly be examined without serious burden on the part of the Examiner.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

If, however, the restriction requirement is maintained, Applicants request rejoinder of the claims of Group II and III once the claims of Group I are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. See 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Id. Accordingly, if the claims of Group I are found allowable, Applicants respectfully request that the claims of Groups II and III be rejoined and examined for patentability. See also M.P.E.P. § 821.04.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

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Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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